

Remarks

Thank you for your work in connection with this application. Following are Applicants' remarks responsive to the Office Action.

Election/Restriction

Applicants affirm the election to prosecute claims 1-30 in this application. Claims 31-44 are canceled without prejudice in this amendment. The election is made without prejudice to the filing of a divisional application.

Amendments

The application is amended as noted. Text deletions are indicated by strike out marks or double bracketing and text additions are underlined.

In the specification, non-substantive typographical errors are corrected as noted.

Trademarks are capitalized throughout the specification as requested. Spelling of the trademark DURTAN is corrected. DURTAN 60 is sorbitan monostearate and pages 5 and 10 of the specification are amended to explicitly reference such sorbitan monostearate.

The Abstract and specification text at 3:3 (reference is to page or column:lines) are amended to make the fat content consistent with the application, for example, at 4:8, 4:17, 6:9 and original claims 1 and 5. The wording at each of the foregoing cited passages includes 16% within the range. Thirteen percent is also within the range.

Page 3 is further amended at lines 20-23 to insert the data consistent with the application at 15:15-16.

Pages 6, 13 and 14 are amended to correct the informalities. Please note that the correction at 6:25 is supported at 14:12.

Page 10, line 2 is amended to state the emulsifier range consistent with the application, for example, at 5:3-7 and original claim 14.

Page 13 is amended at line 12 to correct a typographical error regarding dioxide.

At pages 13 and 14 and in the Examples, the word “flavoring” is amended for consistency with use of that word at, for example, 13:20.

At page 16, Table 2 is amended because the noted numbers were inadvertently reversed. The correction makes Table 2 consistent with the fat content data at 5:18-20, (i.e., 14.23% fat content in a preferred embodiment).

In the claims, claims 1 and 5 are canceled and are rewritten, in part, as new claim 45. Support for new claim 45 is found, for example, in original claims 1, 5, 14 and in the application at 4:15-25, 6:7-13, 9:26 through 10:3, 13:20 through 14:6. Support for the emulsifier range in claim 45 (and new claim 52) is found in the totality of emulsifiers listed at 5:3-7 as well as at 10:1 through 11:2, Example 1 Table 1 wherein four emulsifier constituents are used in combination and original claim 14. New claims 46-48 depend on claim 45.

Claims 49-59 are new. Support for these claims is found in the application, for example, at 4:15-25, 5:3-7, 6:7-13, 9:26 through 10:3, 12:3-9, 12:30-13:8, 13:20 through 14:6, 15:12-16 and original claim 14.

Claim preambles are amended for consistency throughout and dependency corrected. “Butter-flavored topping” as used in the preambles of claims 45, 17, 26 and 28 adequately characterizes the compositions as the constituents and ranges are listed in each claim.

The word “butter” is added to claims 11-13, 17, 20-22, 26 and 28 to better clarify that the composition is a butter-flavored composition. See, for example, application at 13:16 through 14:6.

Claim 16 deletes reference to the DURTAN 60 trade name and inserts sorbitan monostearate in place thereof.

Claim 17 is rewritten as an independent claim.

Claim 26 deletes the second occurrence of “by weight.”

No new matter is added as the amendments are supported in the application as noted

above or are corrections of apparent typographical errors.

Response to Rejections

Rejection under 35 U.S.C. § 112, Second Paragraph

Claim 16 was rejected under § 112, second paragraph because a trademark was included in the list of emulsifiers. Claim 16 is amended to insert sorbitan monostearate in place of the trademark. Withdrawal of the rejection is requested.

Rejection under 35 U.S.C. § 102(b)

Claim 1 was rejected under 35 U.S.C. § 102(b) based on U.S. Patent No. 5,759,609 (Lynch). Claim 1 is canceled and rewritten as new claim 45. Claim 45 is not anticipated by Lynch at least because claim 45 is directed to a composition with a fat content outside the maximum fat content said to be permitted in Lynch. See Lynch Abstract and 2:9. Lynch differs materially from Applicants' claimed compositions in other ways as discussed below. Withdrawal of the rejection is requested.

Rejections under 35 U.S.C. § 103(a)

1. Claims 2-4, 27 and 29

Claims 2-4, 27 and 29 were rejected under 35 U.S.C. § 103(a) based on Lynch and U.S. Patent No. 3,763,900 (Solms-Baruth). Reconsideration is requested.

Applicants' claims 2-4 and 27 depend on one of base claims 45 or 26, each of which defines butter-flavored toppings having fat contents of about 13-16 weight % – amounts which are outside the maximum theoretical and exemplary fat content permitted by Lynch. Lynch at Abstract (0.0% - 7.0% fat), 2:9, Table 1, Examples A-K, constituents 20 and 21 (4.0 % maximum fat). New claim 49 also claims about 13-16 weight % fat.

Lynch teaches directly away from, and is incompatible with, Applicants' compositions as set forth in claims 45, 26 and 49 because Lynch states, that his goal was to develop "a low/no fat, low caloric density desert food product." Lynch at 1:41-45; 2:30-34. See also Lynch's Background of the Invention section. Lynch's Summary of the Invention goes so far as to state that, "This invention is directed to dairy free no fat whipped topping foods which can be stored frozen in an unwhipped state for an indefinite period of time, thawed and whipped into a whipped desert topping." Lynch at 1:48-49. (emphasis added). Lynch repeats the dairy free whipped topping statement at 2:8.

In addition, Lynch requires a high sweetener content consistent with Lynch being a desert topping. Lynch requires 30-55 weight % sweeteners and those sweeteners are the principle source of solids in the composition. Lynch 3:58-60; claims 1 and 23. Emphasis is placed on corn syrups with a DE value of 15 to 65 (preferably 34 to 38), sugar and dextrose. Lynch at 3:64-67. Applicants' independent claims 45, 26, 28, 51 all require about 10-16 weight % bulking agent. Application at 11:21 through 12:13 (Preference for low DE starches to avoid slight sweetness which may be objectionable in a low calorie topping. Application at 12:9-11.)

Lynch does not mention discharging his composition from an aerosol container as required by Applicants' claims 2-4, 27, 29, (or new claim 59). Lynch is an oil in water liquid emulsion which is aerated by whipping the emulsion with a conventional whipper for the incorporation of air. Lynch at 2:9; 3:32-34 and 43-48; 4:66. Lynch can be stored for long periods of time in its liquid state. Lynch at 7:16 through 8:11.

Solms-Baruth is directed to a process for sterilizing and filling aerosol containers with subsequent dispensing of products like whipped cream. Solms-Baruth does not teach or suggest Applicants' compositions as claimed.

The combination of Lynch and Solms-Baruth are, therefore, contrary to the compositions of Applicants' claims 2-4 and 27, their base claims 45 and 26 and new claim 49. Lynch and Solms-Baruth, separately or in combination, do not present the required *prima facie* case of

obviousness. MPEP § 2142 at 2100-133. (Rev. 3, Aug. 2005) (The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.)

Claim 29 depends on claim 28 and requires milk and cream. These dairy constituents are not consistent with a non-dairy whipped topping as asserted by Lynch.

Reconsideration and withdrawal of the rejection is requested.

2. Claims 5 and 12-13

Claims 5 and 12-13 were rejected under § 103(a) based on Lynch in combination with U.S. Patent No. 6,372,280 (Gonsalves). Claim 5 is canceled. Claims 12 and 13 depend on claim 45 discussed above. New claim 49 shares certain elements in common with claim 45.

It is Applicants' respectful position that the combination of Lynch and Gonsalves is improper for the same reason as set forth above regarding claims 2-4 and 27 above, namely Lynch and Gonsalves are incompatible and teach away from their combination. MPEP § 2145 (X)(D)(2) at 2100-169¹ (Rev. 3, Aug. 2005). There must be some suggestion or motivation to combine references. MPEP § 2145(X)(C). The references cannot be combined if they teach away from the invention or render the prior art unsatisfactory for the intended purpose. MPEP § 2145(X)(D). In Applicants' view, these references do not present the *prima facie* case of obviousness required by MPEP § 2142.

As was noted above, Lynch is a no fat/low fat composition. Gonsalves is cited to provide the fat content range missing from, and excluded by, Lynch. However, this is not a situation in which a reference can simply be cited to broaden the range of another patent because Lynch does not permit such a broadening. And, the Lynch and Gonsalves systems differ overall.

¹MPEP § 2145 states, "It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.)."

Gonsalves is directed to a fruit-type acidic (i.e., low pH) whipped topping comprising a mixture of (1) an emulsion component and (2) an edible-acid-containing acidic component. Gonsalves at 2:53 through 3:3; 3:8-12; 4:49-50. Lynch includes no such emulsion and acidic components. It is apparent that Gonsalves' low pH comes from fruit and fruit flavors that are included in the acidic component. 1:62-67; 2:62-66. Lynch mentions fruit flavors only in passing. Lynch at 6:58.

According to Gonsalves, acidic low pH compositions pose special formulation problems because, "most food proteins lose solubility and surface activity at low or reduced pH's (less than 6.0)." Gonsalves at 2:21-22. For example, sodium caseinate, a protein used for emulsification in frozen whipped toppings (and listed as a possible ingredient in Lynch at 6:28-31), is said to precipitate out of solution in low pH compositions. Gonsalves at 2:27-29. Accordingly, Gonsalves requires that whey protein be used as a surfactant because such proteins remain active at low pH values. Gonsalves at 2:35-37; 3:23-28. Whey is not mentioned in Lynch.

Gonsalves includes about 5 to about 20 weight % hard fat, a range which is utterly inconsistent with the maximum 7% fat theoretically allowed in Lynch. Gonsalves at 5:55-56. And, contrary to the "dairy free" claim of Lynch at 2:7-8 and 1:48, Gonsalves states that milk solids and milk protein may be included. Gonsalves at 4:49-51; 5:63-66; Gonsalves Example at 7:40-60 (acidic component includes skim milk).

It is not known why someone of skill in the art would look to the combination of Lynch and Gonsalves as a teaching of Applicants' claims because these references are at odds with one another. It is apparent that Lynch and Gonsalves are based on totally different systems. And, Gonsalves would render Lynch unsatisfactory because Gonsalves would introduce a fat range prohibited by Lynch. The acidic nature of Gonsalves would potentially effect the behavior of at least one of Lynch's potential constituents. Lynch has a very narrowly defined relevance and Gonsalves does not broaden that relevance because the two references are not compatible. These references do not render Applicants' claims 45, 12, 13 or new claim 49 obvious.

As a final comment, Gonsalves is a very sweet food product with a high sweetener content of 40-55 weight % and a preference for corn syrup with a DE of about 35 to about 50. Gonsalves at 3:48-65. Applicants' bulking agents of claim 45 (and claims 49, 54) are outside this range consistent with the fact that Applicants are claiming a butter-flavored topping and not a desert.

3. Claims 6-8, 9-10, 14-15, 18-19, 22, 23-24

Claims 6-8, 9-10, 14-15, 18-19, 22, 23-24 were rejected under § 103(a) based solely on Lynch and assertions of general knowledge in the art. Claims 6-8, 9-10 and 14-15, as amended, depend on new claim 45. Claims 18-19 and 22-24 depend directly or indirectly on claim 17. New claim 49 includes certain elements similar to those of claim 45.

Lynch (alone or in combination with the other cited references) does not render independent claim 45 (or claim 49) obvious for all of the reasons set forth above in connection with claims 2-4, 27 and 29. Accordingly, Lynch does not render dependent claims 6-10, 14-15 obvious.

Claims 18-19 and 22-24 are all directed to a dairy-based topping including whole milk and cream. Such constituents provide a fat content incompatible with Lynch. Milk and cream are incompatible with Lynch's assertions that Lynch is a dairy-free composition. Lynch at 2:7-8 and 1:48. Claim 19 (and claim 55) has a DE value of about 10 which is below the 15-64 range (The preferred DE range is 34-38) of Lynch's sweetened desert topping composition. Lynch at 3:64-66.

Reconsideration of the rejections is respectfully requested.

4. Claims 16 and 25

Claims 16 and 25 were rejected under § 103(a) based on Lynch and U.S. Patent No. 2,831,775 (Kocher). Claims 16 and 25 depend on claims 45 or 17 and are not obvious in view of Lynch for the reasons set forth above in connection with claims 2-4, 27 and 29.

5. Claims 17 and 21

Claims 17 and 21 were rejected under § 103(a) based on Lynch and U.S. Patent Nos. 4,251,560 (Dell) and 2,883,286 (Musser). The cream and milk of Dell and Musser are not compatible with, and are contrary to, Lynch's fat content limit and dairy-free assertions as set forth above in connection with claims 2-4, 27 and 29. See Lynch at 1:48-49 and 2:7-8. Respectfully, this rejection is based on an improper combination of references; withdrawal of the rejections is requested.

6. Claim 26

Independent claim 26 was rejected under § 103(a) based on Lynch and Gonsalves. The combination of Lynch and Gonsalves is not believed to be proper for the reasons set forth above regarding claims 5 and 12-13. Reconsideration and withdrawal of the rejection is requested.

7. Claims 28 and 30

Independent claim 28 was rejected under § 103(a) based on Lynch, Dell and Musser and dependent claim 30 was rejected under § 103(a) based on Lynch and Dell. The combination of Lynch, Dell and Musser and Lynch and Dell is improper for the reasons set forth above regarding claims 17 and 21. Reconsideration is requested.

In re Patent Application of:
Allen C. Buhler et al.
Serial No. 10/646,609

Page 31 of 31

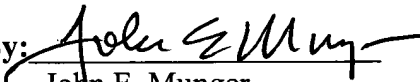
8. Claims 11 and 20

Dependent claims 11 and 20 were rejected under § 103(a) based on Lynch, Russian Patent No. 2,180,177 (Victorovna) and U.S. Patent No. 6,025,005 (Pickenhagen). Claims 11 and 20 add constituents of a preferred flavoring agent. Claims 11 and 20 depend on claims 45 and 17 respectively. Lynch differs from these base claims for the reasons set forth above. Victorovna's constituent weight percentages are wholly outside the ranges of claims 11 and 20 and Victorovna includes many other constituents. Pickenhagen describes propylene glycol but in a different flavoring system. These references do not render claims 11 and 20 obvious.

Conclusion

The Examiner is invited to call the undersigned if that would be of assistance in resolving any outstanding issue regarding this application. The Commissioner is authorized to debit deposit account 10-0270 to pay for any amounts due in connection with this paper. Kindly notify the undersigned in the event that the deposit account is debited or credited.

Respectfully submitted,

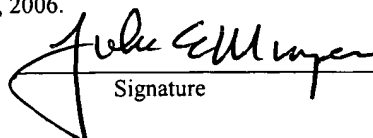
By: 
John E. Munger
Registration No. 37,685

Jansson, Shupe, Munger & Antaramian, Ltd.
245 Main Street
Racine, Wisconsin 53403-1034
(262) 632-6900
Atty. Docket No.: BUTR-101US

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: MAIL STOP AMENDMENT, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 on June 22, 2006.

John E. Munger
Name

 June 22, 2006
Signature Date